



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,244	02/13/2001	Mark Ireton	18235-05421 (S30133US1.1)	1690
20306	7590	10/05/2004	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			STULBERGER, CAS P	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/783,244	IRETON, MARK	
	Examiner	Art Unit	
	Cas Stulberger	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 February 2004 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 7-21, and 23-29 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No 5,745,678 to Herzberg et al.

3. In regards to claims 1-3, 5, 7-12, 14-21, and 23-29, Herzberg discloses determining whether a multimedia program is authorized. In creating the validation structure of the multimedia program, sections of the program are selected and a cryptographic hash value is created or calculated on each of the selected data objects. The hash value and the location of the selected data object are stored as a data record within the validation structure (Herzberg: column 1, lines 61-67). This meets the limitation of “a storage operatively coupled to the analysis module, and for securely storing the known hash value and the control information associated with the digital media file.” A portion of the data objects is selected from the multimedia program using location information (control information) stored in the validation structure. A cryptographic hash value is calculated on the selected data object and compared to the corresponding hash-value-of reference stored in the validation structure (Herzberg: column 2, lines 4-20). This meets the limitation of “an analysis module for determining control information associated with the digital media file and for computing a known hash value that uniquely identifies the digital media file, thereby yielding an analyzed digital media file; a

verification module operatively coupled to the storage and adapted to receive the analyzed digital media file, the verification module for computer a verification hash value from the analyzed digital media file received, and comparing that verification hash value to the known hash value.”

An authorized multimedia program is allowed to execute normally (Herzberg: column 2, lines 27-29). This meets the limitation of “an outtake module adapted to transfer the analyzed digital media file in accordance with the associated control information in response to the verification hash value matching the known hash value.”

4. In regards to claims 4, 13, Herzberg discloses that if the hashes do not match the execution of the multimedia program may be prohibited or limited execution of the program may be allowed (Herzberg: column 2, lines 37-32).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No 5,745,678 to Herzberg et al as applied to claim1-5, 7-21, and 23-29 above, and further in view of U.S. Patent No 6,434,322 B1 to Kimura et al.

7. Herzberg however does not disclose digital watermarking. Kimura discloses a video signal which has electronic watermark information which is embedded in the video signal and has copy control information (Kimura: column 2, lines 6-10).

8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of validating a program as disclosed by Herzberg with the method of including control information in a digital watermark as disclosed by Kimura in order to control reproduction or recording of an original image or to clarify the source of the image (Kimura: column 1, lines 13-15).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cas Stulberger whose telephone number is (703) 305-8034. The examiner can normally be reached on Monday - Friday, 9:00A.M. - 5:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CS

CS

Gilberto Barron
GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100